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Filing date: **11/16/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91201511
Party	Defendant Premier Grocery, Inc.
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Submission	Answer and Counterclaim
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Signature	/StevenBPowell/
Date	11/16/2011
Attachments	SECRET STASH Answer and Counterclaim 11-16-11.pdf (9 pages)(99239 bytes)

Registrations Subject to the filing

Registration No	3360553	Registration date	12/25/2007
Registrant	PARAMOUNT FARMS, INC. 11444 W. OLYMPIC BLVD; 10TH FL LOS ANGELES, CA 90064 UNITED STATES		

Goods/Services Subject to the filing

Class 029. First Use: 2006/06/01 First Use In Commerce: 2006/06/01 All goods and services in the class are requested, namely: Flavored nuts, salted nuts, shelled nuts, roasted nuts; processed nuts; snack mix consisting primarily of processed nuts
Class 031. First Use: 2006/06/01 First Use In Commerce: 2006/06/01 All goods and services in the class are requested, namely: Raw natural nuts

Registration No	3295108	Registration date	09/18/2007
Registrant	PARAMOUNT FARMS, INC. 11444 W. OLYMPIC BLVD., 10TH FL. LOS ANGELES, CA 90064 UNITED STATES		

Goods/Services Subject to the filing

Class 029. First Use: 2006/06/01 First Use In Commerce: 2006/06/01 All goods and services in the class are requested, namely: Flavored nuts, salted nuts, shelled nuts, roasted nuts; processed nuts; snack mix consisting primarily of processed nuts
Class 031. First Use: 2006/06/01 First Use In Commerce: 2006/06/01 All goods and services in the class are requested, namely: Raw natural nuts

PARAMOUNT FARMS INTERNATIONAL, LLC,)	
)	Opposition No. 91201511
Opposer)	
)	Application Serial No. 85/197,617
vs.)	
)	Mark: SECRET STASH
PREMIER GROCERY, INC.,)	
)	Application Filing Date: Dec. 14, 2010
Applicant.)	
)	

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

1. Applicant denies that Opposer has used the marks STACH, ADVENTURES OF STACH, or any other mark containing the element STACH in commerce in connection with the goods “processed and natural nuts.” Applicant lacks knowledge or information sufficient to form a belief as to the remaining allegations in Paragraph 1 of the Notice of Opposition, and on that basis denies such allegations.

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3. Applicant denies the allegations contained in Paragraph 3 of the Notice of Opposition.

4. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 4 of the Notice of Opposition, and on that basis denies such allegations.

5. Applicant denies the allegations contained in Paragraph 5 of the Notice of Opposition.

6. Applicant admits that Applicant applied for registration of the mark SECRET STASH for use in connection with “rice-based snack foods,” in International Class 30. Applicant lacks knowledge or information sufficient to form a belief as to the remaining allegations in Paragraph 6 of the Notice of Opposition, and on that basis denies such allegations.

7. Applicant denies that Applicant has used the marks defined in the Notice of Opposition as “the STACH Marks” or any mark containing the element STACH. Applicant lacks knowledge or information sufficient to form a belief as to the remaining allegations in Paragraph 7 of the Notice of Opposition, and on that basis denies such allegations.

8. Applicant admits that Applicant has not used the STACH Mark. Applicant lacks knowledge or information sufficient to form a belief as to the remaining allegations in Paragraph 8 of the Notice of Opposition, and on that basis denies such allegations.

9. Applicant denies the allegations contained in Paragraph 9 of the Notice of Opposition.

The remaining allegations are prayers for relief that do not require an admission or denial by Applicant. To the extent a response is required, the allegations are denied. Unless specifically admitted herein, all allegations in the Notice of Opposition are denied. Applicant

further denies that Opposer is entitled to any relief, including the relief requested in the Notice of Opposition.

AFFIRMATIVE DEFENSES

First Affirmative Defense

Opposer's claims are barred by the doctrine of unclean hands.

Second Affirmative Defense

Opposer's marks have been abandoned.

Third Affirmative Defense

Opposer has not used the marks STACH or ADVENTURES OF STACH in commerce connection with the goods alleged in the Notice of Opposition.

Fourth Affirmative Defense

The registrations cited in the Notice of Opposition are void because the marks were not in use in commerce in connection with the goods as of the filing dates of the Statements of Use.

Fifth Affirmative Defense

Registration of Applicant's Mark would not result in a likelihood of confusion.

Sixth Affirmative Defense

Opposer's marks are weak.

Seventh Affirmative Defense

Opposer's marks fail to function as trademarks in connection with the goods.

WHEREFORE, having fully answered, Applicant Premier Grocery, Inc. prays for judgment against Paramount Farms International, LLC, dismissing its Notice of Opposition with

prejudice, and awarding Applicant such other and further relief as the Board deems just and equitable.

**APPLICANT’S COUNTERCLAIM AND PETITION FOR CANCELLATION
OF OPPOSER’S REGISTRATION NOS. 3,360,553 AND 3,295,108**

Premier Grocery, Inc. (“Applicant-Petitioner”), a corporation organized under the laws of California, having a place of business at 11811 N. Tatum Boulevard, #2400, Phoenix, Arizona, 85028, believes that it is and will continue to be damaged by the above-identified registrations of Paramount Farms International, LLC, a limited liability company organized under the laws of Delaware, having a place of business at 11444 W. Olympic Boulevard, 10th Floor, Los Angeles, California 90064 (“Opposer-Registrant”), and pursuant to 15 U.S.C. § 01604 et seq. and 37 C.F.R. § 2.111 et seq., hereby counterclaims in its petition to cancel the same.

As grounds for cancellation, Applicant-Petitioner alleges as follows:

1. On December 14, 2010, Applicant-Petitioner filed an intent-to-use-based application for federal registration of the mark SECRET STASH on the Principal Register in Class 30 in connection with “rice-based snack foods.” Petitioner’s application, accorded Application Serial No. 85/197,617, was allowed by the United States Patent and Trademark Office (“USPTO”) and published for Opposition on May 10, 2011.

2. On September 7, 2011, Opposer-Registrant filed a notice of opposition (the “Notice of Opposition”), initiating the present opposition proceeding subsequently accorded Opposition No. 91201511, opposing registration of Applicant-Petitioner’s Application Serial No. 85/197,617 on likelihood-of-confusion grounds.

3. In the Notice of Opposition, Opposer-Registrant cites its ownership of a federal registration for the mark STACH, Reg. No. 3,360,553, which was registered on the Principal Register on December 25, 2007 for use in connection with only the following goods: “flavored

nuts, salted nuts, shelled nuts, roasted nuts, processed nuts, snack mix consisting primarily of processed nuts,” in International Class 29, and “raw natural nuts,” in Class 31.

4. The Statement of Use filed by Opposer-Registrant in connection with Application Serial No. 78/713,108, which matured into Reg. No. 3,360,553, included a declaration signed by Craig B. Cooper as Sr. Vice President of Paramount Farms, Inc. dba Everybody’s Nuts, alleging that the STACH mark was in use in commerce in connection with all the goods identified in Application Serial No. 78/713,108 on the date the Statement of Use was filed, August 13, 2007.

5. The Statement of Use for Application Serial No. 78/713,108 was accompanied by purported specimens of use that consisted of photo images of packaging for roasted pistachios, plus a comic strip which was a package insert, as identified on the packaging by the wording “comic inside.”

6. The only place the word STACH appears on the purported specimens of use for Application Serial No. 78/713,108 is on the package insert comprising comic strips.

7. Opposer-Registrant’s use of the word STACH on the comic strip enclosed inside the packaging does not satisfy the trademark affixation requirement of Lanham Act § 1, 15 U.S.C.A. § 1051.

8. Because the STACH mark was not in use in commerce in connection with the goods identified in Application Serial No. 78/713,108 on the date the Statement of Use was filed, Opposer-Registrant’s Reg. No. 3,360,553 is void *ab initio*.

9. In the Notice of Opposition, Opposer-Registrant cites its ownership of a federal registration for the mark ADVENTURES OF STACH, Reg. No. 3,295,108, which was registered on the Principal Register on September 18, 2007 for use in connection with only the following

goods: “flavored nuts, salted nuts, shelled nuts, roasted nuts, processed nuts, snack mix consisting primarily of processed nuts,” in International Class 29, and “raw natural nuts,” in Class 31.

10. The Statement of Use filed by Opposer-Registrant in connection with Application Serial No. 78/713,114, which matured into Reg. No. 3,295,108, included a declaration signed by Craig B. Cooper as Sr. Vice President of Paramount Farms, Inc. dba Everybody’s Nuts, alleging that the ADVENTURES OF STACH mark was in use in commerce in connection with all the goods identified in Application Serial No. 78/713,114 on the date the Statement of Use was filed, February 22, 2007.

11. The Statement of Use for Application Serial No. 78/713,114 was accompanied by purported specimens of use that consisted of photo images of packaging for roasted pistachios, plus a comic strip which was a package insert identified on the packaging by the wording “comic inside.”

12. The only place the wording ADVENTURES OF STACH appears on the purported specimens of use for Application Serial No. 78/713,114 is on the package inserts comprising comic strips.

13. Opposer-Registrant’s use of the wording ADVENTURES OF STACH on the comic strip enclosed inside the packaging does not satisfy the trademark affixation requirement of Lanham Act § 1, 15 U.S.C.A. § 1051.

14. Because the ADVENTURES OF STACH mark was not in use in commerce in connection with the goods identified in Application Serial No. 78/713,114 on the date the Statement of Use was filed, Opposer-Registrant’s Reg. No. 3,295,108 is void *ab initio*.

15. On information and belief, Opposer-Registrant has not used the STACH mark or the ADVENTURES OF STACH mark in commerce in connection with the goods “snack mix consisting primarily of processed nuts.”

16. On information and belief, Opposer-Registrant has not used the STACH mark or the ADVENTURES OF STACH mark in commerce in connection with the goods “raw natural nuts.”

17. On information and belief, Opposer-Registrant has not used the STACH mark or the ADVENTURES OF STACH mark in commerce in connection with the goods “flavored nuts.”

18. On information and belief, Opposer-Registrant has not used the STACH mark or the ADVENTURES OF STACH mark in commerce in connection with the goods “salted nuts.”

19. On information and belief, Opposer-Registrant has not used the STACH mark or the ADVENTURES OF STACH mark in commerce in connection with the goods “shelled nuts.”

20. On information and belief, Opposer-Registrant has not used the STACH mark or the ADVENTURES OF STACH mark in commerce in connection with the goods “roasted nuts.”

21. On information and belief, Opposer-Registrant has not used the STACH mark or the ADVENTURES OF STACH mark in commerce in connection with the goods “processed nuts.”

22. On information and belief, Opposer-Registrant has not used the STACH mark in commerce in connection with any goods identified in Reg. No. 3,360,553.

23. On information and belief, Opposer-Registrant has not used the ADVENTURES OF STACH mark in commerce in connection with any goods identified in Reg. No. 3,295,108.

24. As used by Opposer-Registrant, the marks STACH and ADVENTURES OF STACH fail to function as trademarks in connection with any goods identified in Reg. Nos. 3,360,553 and 3,295,108.

25. Opposer-Registrant is not entitled to continued registration of its Reg. Nos. 3,360,553 and 3,295,108 because the registrations are void *ab initio*.

26. Applicant-Petitioner is likely to be damaged by Reg. Nos. 3,360,553 and 3,295,108 because Opposer-Registrant has relied on the rights claimed in said Registrations in its Notice of Opposition opposing registration of Applicant-Petitioner's Serial No. 85/197,617 for the mark SECRET STASH, alleging a likelihood of confusion between Applicant-Petitioner's mark and Opposer-Registrant's marks.

27. In view of the allegations set forth above, and on the grounds set forth above, Applicant-Petitioner requests that Opposer-Registrant's Registration Nos. 3,360,553 and 3,295,108 be cancelled and declared void *ab initio*.

WHEREFORE, Applicant-Petitioner respectfully prays that the Board order that Registration Nos. 3,360,553 and 3,295,108 be cancelled on the grounds set forth herein and award Applicant such other and further relief as the Board deems just and equitable.

Dated: November 16, 2011

Respectfully submitted,

GREENBERG TRAURIG, LLP

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CERTIFICATE OF SERVICE

I hereby certify that on November 16, 2011, a true and correct copy of the foregoing Applicant's Answer to Notice of Opposition and Counterclaim for Cancellation of Opposer's Registration Nos. 3,360,553 and 3,295,108 was served via First Class Mail, postage prepaid, on counsel for Opposer:

Danielle M. Criona, Esq.
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